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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/692,463	10/21/2003	Brian LaBrec	P901D	7258
23735 7590 01/25/2008 DIGIMARC CORPORATION 9405 SW GEMINI DRIVE BEAVERTON, OR 97008				
			EXAMINER CHEN, VIVIAN	
			ART UNIT 1794	PAPER NUMBER
			MAIL DATE 01/25/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/692,463	Applicant(s) LABREC, BRIAN	
	Examiner Vivian Chen	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,9,11,12,15-17,19,30 and 31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11,12,15,16,30 and 31 is/are allowed.
- 6) ☒ Claim(s) 1-7,9,17, 19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1794

DETAILED ACTION

1. Claim 8, 10, 13-14, 18, 20-29, 32-33 has been cancelled by Applicant.

Specification

1. The amendment filed 4/30/2007 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the newly filed amendments in which the document structure lacks a discernable interface between laminate and core when the core is not also specified as comprising a polyester or a polyester component.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-7, 9 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed

Art Unit: 1794

invention for the reasons stated above in the objection to the amendment filed 4/30/2007. The disclosure as originally filed only provides support for the lack of a discernable interface when the core is specified as polyester and does not provide support for the lack of a discernable interface when the core is not specified as comprising polyester or a polyester component.

Claim Rejections - 35 USC § 103

4. Claims 17, 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over:

(a) WINTER (US 4,765,999); or

(b) YABE (US 4,362,775).

WINTER discloses a method of forming a laminated polyester film via coextrusion wherein the laminate comprises a first polyester layer comprising PCTA and a second bonding layer comprising PETG. The film can be adhered to other materials (e.g., the paper layer of a popcorn bag) via the bonding layer. (WINTER, line 9-23, 33-58, col. 2; line 66, col. 3; Examples 1-3)

YABE ET AL discloses a method of forming a laminated polyester film via coextrusion wherein the laminate comprises a first polyester layer comprising poly-1,4-cyclohexylenedimethylene terephthalate and a second bonding layer comprising glycol-modified polyethylene terephthalate. The film is adhered via the bonding layer to a printable substrate. (YABE ET AL, line 1-2, 40-50, col. 2; line 6-38, col. 3; line 1-5, col. 8)

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to utilize a known multilayer film-forming method (e.g., coextrusion) to form a laminate comprising a surface polyester layer and a bonding polyester layer, wherein the

Art Unit: 1794

laminate is subsequently adherable to another material or substrate via the bonding layer. With respect to the claim language "for a document" and "for bonding directly to a core layer of a document", a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Since the term "document" broadly refers to something which conveys information, any material which can be printed may be reasonably considered a "document" and since it is also well known in the art to apply printing to the various layers of a packaging material or container in order to provide information -- for example, printing heating instructions, warnings, and/or nutritional information on the outside surface of microwavable popcorn bags or other types of packaging materials, containers, etc. -- the laminates disclosed in WINTER and YABE ET AL disclosed as being suitable for use in packaging applications are capable of forming documents since they are capable of conveying or representing some form of information.

Response to Arguments

5. Applicant's arguments filed 11/13/2007 have been fully considered but they are not persuasive.

(A) Applicant argues that the specification provides support for the lack of a discernible interface between the laminate and core as presently recited in claim 1. However, while the composition of the core is not limited solely to polyester and while the specification provides

Art Unit: 1794

support for the lack of such an interface when the core is specified to be polyester, the disclosure as originally filed does not provide support for the lack of said interface when the core comprises any other material except polyester. Furthermore, Applicant's reliance on previously presented claim 32 is misplaced because the claim required the core to comprise polyester and the claim language clearly indicates that the presence of the polyester in the core is a critical aspect to achieving the lack of a discernable interface, which thereby supports the Examiner's position that the disclosure as originally filed does not provide support for the absence of said interface in circumstances when the core does not comprise polyester.

(B) Applicant argues that YABE ET AL and WINTER fail to claim laminates for documents. However, with respect to the claim language "for a document" and "for bonding directly to a core layer of a document" in claim 17, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Since the term "document" broadly refers to something which conveys information, any material or object which can be printed may be reasonably considered a "document". Since it is also well known in the art to apply printing to the various layers of a packaging material or container in order to provide information -- for example, printing heating instructions, warnings, and/or nutritional information on the outside surface of microwavable popcorn bags or other types of packaging materials, containers, etc. -- the laminates disclosed in WINTER and YABE ET AL (disclosed as being suitable for use in packaging applications) are capable of being used to form a "document" because they are capable of conveying or representing printed information.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 1794

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vivian Chen whose telephone number is (571) 272-1506. The examiner can normally be reached on Monday through Thursday from 8:30 AM to 6 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano, can be reached on (571) 272-1398. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

The General Information telephone number for Technology Center 1700 is (571) 272-1700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

January 18, 2008



Vivian Chen
Primary Examiner
Art Unit 1794